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Attorney Docket No.: 42.P12963

Application No.: 09/598,680

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REMARKS

Claims 1-9 and 11 remain pending.

In the Office Action, the Examiner rejected, *pro forma*, claims 1-9 and 11 under 35 U.S.C. § 101.

A fifth consecutive non-final action definitely constitutes piecemeal examination under M.P.E.P. § 707.07(g):

A fifth, consecutive non-final Office Action is improper, period. It is particularly improper where, as explained below, the fifth Office Action is non-responsive. This application has been under "examination" since the first non-final Office Action way back in February, 2004. While the Examiner may have no problem with issuing five non-final Office Actions in an application over the course of nearly three years, Applicants find this unreasonable, burdensome, and an abuse of the discretion granted the Examiner by the Director.

Under these circumstances, a petition under 37 C.F.R. § 1.181 to invoke the Director's supervisory authority is appropriate:

The facts are these. Applicants are responding to a fifth, consecutive non-final Office Action. At least the past three Office Actions (including the pending one) have contained rejections that were legally and factually insufficient to establish a *prima facie* case under any section of 35 U.S.C. In short, these actions were without merit, and yet they kept coming. As explained below, the current Office Action is a *verbatim* repeat of the cursory, conclusory § 101 "rejection" in the prior Office Action. Also as explained below, the current Office Action ignores the instruction in M.P.E.P. § 707.07(f) to answer all material traversed.

The undersigned sees a pattern in the above behavior, namely a willful refusal to allow the claims to issue, coupled with an unwillingness or inability to make a proper, factually supported *prima facie* case of unpatentability. Both are inappropriate in an *ex parte* proceeding.

Accordingly, Applicants respectfully invoke the supervisory authority under 37 C.F.R.

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§ 1.181 and petition the Director to review the file history, the claims, and the current § 101 “rejection,” and direct the Examiner to either 1) make a proper, complete, reasoned, and factually supported rejection, or 2) allow the claims to issue as a patent.

§ 101 Rejection:

Page 2 of the Office Action contains the identical three line, conclusory § 101 “rejection” as the prior Office Action. This is followed by about four pages of boilerplate language concerning § 101 rejections generally. These four pages do not mention or otherwise relate to either the conclusory “rejection” above or, more importantly, pending claims 1-9 and 11. Thus, the Office Action neither supplements the earlier rejection nor answers Applicants’ traversal of that rejection. This is unacceptable.

The same rejection being received, the same traversal is again set forth below.

Applicants respectfully remind the Examiner of her duty under M.P.E.P. § 707.07(f) to “take note of the applicant’s argument and answer the substance of it.” Applicants also respectfully request that Primary Examiner Temica Beamer more carefully review any future actions before signing them.

A. No *prima facie* case has been established.

The sum total rationale for the § 101 rejection, quoted from page 2 of the Office Action, is:

The claimed subject matter fails to result in a physical transformation nor does it appear to provide a useful, concrete and tangible result.

This is a bare legal conclusion, and does not meet the Examiner’s evidentiary burden of establishing a *prima facie* case of unpatentability. The Examiner has not “explain[ed] in the record the basis for why a claim is [considered to be] for an abstract idea with no practical application.” (See Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (22 November 2005), Section IV(D) “Establish on the Record a Prima Facie Case.”

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Because a *prima facie* case of unpatentability has not been established, the stated § 101 rejection is improper and should be withdrawn.

B. Such a case cannot be established.

For completeness, Applicants note the following. Claims 1-9 and 11 as a whole are useful and produce at least the practical result of compensating for inter-modulation distortion (IMD) present in signals received from a second modem. Compensating for inter-modulation distortion is decidedly useful and practical. See the Background section of the specification, pages 3-7. To characterize any of these claims, as a whole, as not being useful is incorrect.

Reconsideration and allowance of pending claims 1-9 and 11 is respectfully requested.

In the event that any outstanding matters remain in this application, Applicants request that the Examiner contact Alan Pedersen-Giles, attorney for Applicants, at the number below to discuss such matters.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0221 and please credit any excess fees to such deposit account.

Respectfully submitted,

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